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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,692	01/14/2002	Hans Rudolf Muller	EPROV 17	8615

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EXAMINER

BERCH, MARK L

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 08/27/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

16-030,692

Applicant(s)

Examiner

Art Unit

1624

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 August 2003. FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY (check either a) or b))

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
 ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 18 August 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
 2. ☒ The proposed amendment(s) will not be entered because:
 (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ they raise the issue of new matter (see Note below);
 (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See memo.

3. ☒ Applicant's reply has overcome the following rejection(s): Description issue on claim 32.
 4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
 6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
 7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 30

Claim(s) objected to: 14, 17 and 19

Claim(s) rejected: 1-13, 18, 29, 31 and 32

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
 9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
 10. ☒ Other: PTO-1449

DETAILED ACTION

The amendment filed 8/18/2003 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because: The proposed amendment raises new issues that would require further consideration and/or search.

The new choice (ii) of phosphane is unclear. The only meaning that the examiner is aware of for this term is as a synonym for phosphine. However, since "phosphine" was already recited in choice (i), it is apparent that applicants intend to add something different with this new choice (ii), but what is it?

Also, Claim 6 has the term "heterohydrocarbon radical". Entry of the amendment would necessitate reintroducing item 2 of the First Action on the Merits. What does it mean? The term seems contradictory, since the sole requirement for a hydrocarbon radical is that it not contain a heteroatom.

Also, Claim 19 as rewritten is unclear. It begins by setting forth 4 categories of catalysts, but the actual catalysts all fall into category (iv), and even there, are narrower in that the category has 5-10, but the species have 5-7. The same problem would occur in claim 14.

The amendment would not have fixed point 5. It simply duplicates material already present in the claim. It would appear from the presence of choice (iv) that choice (i) is not intended to cover bidentate phosphines, but if so, the claim language does not reflect applicants' intention. That is, choice (i) already covers bidentate phosphines, and tridentate ones too for that matter. But the presence of choice (iv) seems to imply that applicants do not intend choice (i) to cover the bidentates.

The description problem for claim 32 is taken care of. The PTO-1449 should be enclosed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Berch whose telephone number is 703-308-4718. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 308-4716. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 708-308-1235.



Mark L. Berch
Primary Examiner
Art Unit 1624

August 22, 2003